

IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF VIRGINIA  
RICHMOND DIVISION

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ePLUS, INC.,  
Plaintiff,  
v.  
LAWSON SOFTWARE, INC.,  
Defendant.  
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:  
: Civil Action  
: No. 3:09CV620  
:  
: January 20, 2011  
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COMPLETE TRANSCRIPT OF **JURY TRIAL**  
BEFORE THE HONORABLE ROBERT E. PAYNE  
UNITED STATES DISTRICT JUDGE, AND A JURY

APPEARANCES:

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1 (The proceedings in this matter commenced at  
2 9:15 a.m.)

3 (The jury is not present.)

4 THE CLERK: Civil Action No. 3:09CV00620,  
5 ePlus, Incorporated v. Lawson Software, Incorporated.

6 Mr. Scott L. Robertson, Mr. Craig T. Merritt,  
7 Ms. Jennifer A. Albert, and Mr. Michael G. Strapp  
8 represent the plaintiff. Mr. Daniel W. McDaniel,  
9 Mr. Dabney J. Carr, IV, Ms. Kirstin L. Stoll-DeBell,  
10 Mr. William D. Schultz, and Ms. Rachel C. Hughey  
11 represent the defendant.

12 Are counsel ready to proceed?

13 MR. ROBERTSON: Yes, Your Honor.

14 MR. McDONALD: Yes, Your Honor.

15 THE COURT: What do you need to see me about?

16 MR. McDONALD: I think we worked out all the  
17 issues on the Hilliard slides. I think the only thing  
18 that was outstanding was these jury questions.

19 MR. ROBERTSON: There is also --

20 THE COURT: I don't need the jury questions,  
21 to deal with them now.

22 MR. ROBERTSON: All right.

23 THE COURT: Oh, the questions raised by the  
24 jury. Oh, yes. What do you want to do about the  
25 questions? Where is that thing that was submitted

1 yesterday? Court Exhibit 4.

2 Are P.O. Writer and J-CON patented, if so,  
3 when? Didn't Dr. Staats say that it was within a  
4 year?

5 Basically, what he said is for them to  
6 remember. So was the J-CON system only used for  
7 automotive purposes and couldn't be used, all that big  
8 long text is something he testified to or didn't, and  
9 they'll have to remember that testimony. And you-all  
10 will address it in argument; is that right?

11 MR. McDONALD: I think that's fair, Your  
12 Honor.

13 MR. ROBERTSON: Your Honor, I think the real  
14 response, what I would suggest, Your Honor, is that  
15 just you need not concern yourself with it. Whether  
16 the J-CON system addressed auto parts or medical  
17 systems, the J-CON system is not prior art in this  
18 case, and that's why they don't need to consider it.  
19 Dr. Shamos didn't over any opinions with respect to it  
20 and I think this is just ripe for confusion if we say  
21 it had some significance.

22 The same thing with were P.O. Writer and  
23 J-CON patented. That's evidence of some confusion on  
24 the part of the jury. First of all, they need not  
25 concern themselves with whether J-CON or P.O. Writer

1 were patented at all because that was no bearing on  
2 any issue in this case. Moreover, J-CON and P.O.  
3 Writer are not prior art because there's been no  
4 opinions on them.

5 THE COURT: I'm just going to tell them I'll  
6 deal with this later.

7 MR. ROBERTSON: All right. There's one other  
8 issue I wanted to bring to the Court's attention. In  
9 the final pretrial order, there's a factual issue with  
10 whether some of the claims had an adequate written  
11 description as phrased. There's been no evidence  
12 offered with respect to it.

13 THE COURT: They are still in their case.

14 MR. ROBERTSON: I'm sorry?

15 THE COURT: They are still in their case.

16 MR. ROBERTSON: They already called Dr.  
17 Shamos and they're not presenting any additional  
18 evidence on that. That's been represented to me by  
19 Mr. McDonald.

20 THE COURT: Okay. He's the last witness, so  
21 there's no more evidence on it.

22 MR. ROBERTSON: There's no evidence on it  
23 whatsoever. So my question is do I need to call Dr.  
24 Weaver? It's not that I need to rebut anything, but  
25 Dr. Weaver is prepared to offer opinions that there is

1 an adequate written description. I don't want to  
2 waste the jury's time with respect to this, but quite  
3 frankly, I think --

4 THE COURT: What do you want me to do?  
5 Advise you on how to try your case?

6 MR. ROBERTSON: No.

7 THE COURT: I can't do that.

8 MR. ROBERTSON: I think ePlus is entitled to  
9 a JMOL --

10 THE COURT: Then make it at some point after  
11 the case is over.

12 MR. ROBERTSON: I'll do that. I want to be  
13 able to release Dr. Weaver, but I won't do that until  
14 I hear what the Court's ruling is, I gather.

15 THE COURT: I don't think it's a good idea to  
16 rule in apprehendo. I'll wait until the right time  
17 and then rule.

18 Are we ready for the jury?

19 MR. McDONALD: Yes.

20 MR. ROBERTSON: Yes.

21 THE COURT: All right. We're ready.

22 (The jury is present.)

23 THE COURT: You can outsmart yourself. So I  
24 wouldn't have the problem with the donuts that I had  
25 the last time waiting, I called ahead and ordered

1     them. But they gave them to somebody else. I'm not  
2     getting anymore donuts. So I had to wait anyway.

3             THE JURY: We appreciate it.

4             THE COURT: Dr. Shamos, you can come on back  
5     to the witness stand. Thank you, sir.

6             DR. SHAMOS: Good morning.

7             THE COURT: Good morning.

8             I'll deal with the question that was asked  
9     later. Okay? At the end of the day yesterday.

10            Dr. Shamos, I just remind you you're under  
11     the same oath which you took yesterday.

12            THE WITNESS: Yes, Your Honor.

13            MR. ROBERTSON: May I proceed, Your Honor?

14            THE COURT: Sure.

15

16            CROSS-EXAMINATION

17     BY MR. ROBERTSON:

18     Q     Good morning, Dr. Shamos.

19     A     Good morning.

20     Q     Dr. Shamos, these questions were asked of Dr.  
21     Weaver, so I'd like to just ask them of you as well.  
22     You are a retained expert on behalf of Lawson; is that  
23     right?

24     A     Yes.

25     Q     And you are charging Lawson \$550 an hour for

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1     testifying as an expert; is that right?

2     A     The firm that I work for charges \$550 an hour,  
3     yes.

4     Q     That's Expert Engagements, that's the firm you  
5     work for that locates expert services for law firms?

6     A     Yes.

7     Q     But, in fact, you're the president of Expert  
8     Engagements, aren't you?

9     A     Yes.

10    Q     And so when you pay the firm, you're the owner of  
11    the firm, right?

12    A     Well, I'm the owner of the firm, but the firm has  
13    expenses, and the firm does not pay me \$550 an hour.

14    Q     And your wife, she is the vice president of the  
15    firm?

16    A     Yes.

17    Q     Are you the only two principals of the company?

18    A     Yes.

19    Q     And did you testify in your deposition that when  
20    you take the stand and are under oath, literally  
21    anytime you're under oath, your company then charges  
22    \$750 for your testimony; is that right?

23    A     Yes.

24    Q     So you have a premium when you're under oath?

25    A     Yes.



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1 Q Did you testify at your deposition about eight  
2 months ago that at that point you had already charged  
3 Lawson over \$175,000 for your services?

4 A I don't think that was the right number.

5 Q What was the number?

6 A Well, I don't think it could have been that high,  
7 although possibly at that time if it included  
8 expenses, travel expenses, and things like that.

9 Q Do you have your --

10 THE COURT: Mr. Langford, I think there's  
11 something.

12 Q Your deposition is in that notebook?

13 THE COURT: Do you have the deposition there,  
14 Doctor?

15 THE WITNESS: I have a large notebook. The  
16 first thing in the notebook, yes.

17 THE COURT: It does have it in there?

18 THE WITNESS: Yes.

19 Q Would you just turn to the deposition at page 244,  
20 please?

21 A Yes.

22 Q I'm sorry. Specifically, at line 17 to 20, you  
23 were asked the following question: What's the dollar  
24 amount that you billed Merchant & Gould for your  
25 services in this case?

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1           You gave the following answer: Well, I haven't  
2 billed for June yet, but it's very close to \$176,000.  
3 Do you see that?

4       A     Yes.

5       Q     Was that accurate that?

6       A     Yes.

7       Q     You've charged considerably more since that time,  
8 haven't you, sir?

9       A     Well, I've certainly charged more. This is the  
10 gross amount that includes expenses also.

11      Q     Let's talk about what's in this case and what's  
12 not in this case for a little bit, sir. You testified  
13 yesterday about the J-CON system?

14      A     Yes.

15      Q     That is this auto parts point of sale system that  
16 Mr. Staats testified about?

17      A     I wasn't here for Mr. Staats' testimony, but he's  
18 associated with J-CON.

19      Q     Have you read Mr. Staats' testimony from the prior  
20 case?

21      A     I think I read some of it, yes.

22      Q     Now, you had one slide on J-CON; do you recall  
23 that?

24      A     Yes.

25      Q     And you indicated it was an electronic sourcing

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1 system; is that right?

2 A Yes.

3 THE COURT: Can we take a look at the '683  
4 patent, for example.

5 Q Now, this is a claim that's at issue in this case,  
6 and it says it's an electronic sourcing system  
7 comprising, do you see that?

8 A I don't see anything yet.

9 THE COURT: Is yours not up, sir?

10 THE WITNESS: It's not on my screen.

11 THE COURT: He doesn't have anything. Does  
12 he have to touch his like I do?

13 THE WITNESS: It's up now.

14 Q Do you see it now? This is Claim Three of the  
15 '683 patent, which is one of the asserted claims,  
16 correct?

17 A Yes.

18 Q It says an electronic sourcing system comprising,  
19 do you see that?

20 A Yes.

21 Q Then it has six elements, right?

22 A Yes.

23 Q And "comprising" means that it has to include all  
24 those elements or it can others, right? You  
25 understand that?

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1 A Yes.

2 Q So the electronic sourcing system here is a very  
3 specific electronic sourcing system that has to have  
4 at least all six of these elements, right, sir?

5 A Yes.

6 Q So when you said that the J-CON system was an  
7 electronic sourcing system, you weren't talking in  
8 terms that J-CON had all these elements, correct?

9 A I didn't testify to that, no.

10 Q You didn't give any specific testimony on an  
11 element by element, claim by claim basis with respect  
12 to J-CON, correct?

13 A That's right.

14 Q In fact, you offered zero opinions that the J-CON  
15 system from any version from 1988 to 1992 rendered any  
16 of the 12 asserted claims here obvious in any way,  
17 shape or form; isn't that right?

18 A Not in this courtroom, no.

19 Q Well, that's what's important. We're in the this  
20 courtroom, right? So is the answer to my question you  
21 offered zero opinions that J-CON invalidated or  
22 rendered obvious any of the 12 claims?

23 A It's the same question, and I'm giving you the  
24 same answer. I didn't do it in this courtroom.

25 Q Can you answer the question fairly yes or no? Did

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1 you offer it in this courtroom?

2 MR. McDONALD: Objection, Your Honor, asked  
3 and answered.

4 THE COURT: Sustained.

5 Q Did you --

6 THE COURT: It doesn't make any difference  
7 what he's testified to elsewhere, ladies and  
8 gentlemen. It's only what is testified to here that  
9 is important.

10 MR. ROBERTSON: Thank you, Your Honor.

11 BY MR. ROBERTSON:

12 Q You offered zero opinions that J-CON anticipated  
13 any of the 12 claims at issue in this case here,  
14 correct?

15 A In this room.

16 Q You offered zero opinions that J-CON in  
17 combination with any other prior art reference  
18 invalidates the claims in this courtroom, right?

19 A Right.

20 Q You are the only Lawson expert testifying on  
21 invalidity opinions, right?

22 A I believe so.

23 Q You don't know of any other Lawson expert on  
24 invalidity, do you?

25 A No.

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1 Q So as far as the jury is concerned with regard to  
2 the testimony on J-CON, they can forget about that for  
3 any purposes of an element by element, claim by claim  
4 analysis for anticipation and obviousness, right?

5 A I don't know if it's my place to say what the jury  
6 can forget about.

7 Q But you didn't give them any opinions that it  
8 invalidates any claims, right?

9 A Not in this courtroom.

10 THE COURT: Well, you didn't give the jury  
11 any, Dr. Shamos, so it had to be in this courtroom.  
12 So the answer to that is no.

13 THE WITNESS: Correct.

14 Q And let me ask you this: You put up --

15 MR. ROBERTSON: Can you put up just the cover  
16 page of Defendant's Exhibit No. 96, please.

17 Q Now, you showed this J-CON manual, Volume I, cover  
18 page, correct?

19 A Yes.

20 Q That's the only thing you offered to the jury when  
21 you brought up J-CON, this cover page that has the  
22 title of the manual, and that's it, right?

23 A No, I had a slide with the bullet points about  
24 J-CON.

25 Q I'm talking about this exhibit, Defendant's

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1 Exhibit 96. This is what, I think, was represented by  
2 Mr. McDonald that had thousands of pages. I'll accept  
3 that representation. This is the only page of  
4 Defendant's Exhibit 96 that you showed to the jury;  
5 isn't that right?

6 A Yes.

7 Q You didn't discuss a single substantive page in  
8 this manual that contains thousands of pages, right?

9 A I think I testified that it had over a thousand  
10 pages, not thousands. No, that's the only page that  
11 was shown.

12 Q With respect to P.O. Writer that was discussed,  
13 similarly you offered zero opinions that P.O. Writer  
14 rendered obvious any claim at issue here, correct?

15 A In this courtroom.

16 Q And you offered zero opinions that P.O. Writer  
17 anticipates any element or any claim of the patents  
18 that are asserted here, correct?

19 A In this courtroom.

20 Q So you know of no other invalidity expert who's  
21 going to offer opinions on P.O. Writer, do you?

22 A No.

23 Q Let's talk a little bit about RIMS now, if we can.  
24 You reviewed the inventor's deposition testimony in  
25 preparation for your expert report, correct?

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1 A Yes.

2 Q And you're aware that the RIMS system starting  
3 perhaps in the late '80s all the way up until the year  
4 2000 went through many iterations, correct, many  
5 different versions?

6 A Yes.

7 Q Which version are you relying on when you are  
8 rendering your opinions?

9 A That described in the '989 patent.

10 Q So it's only confined to the '989 patent, right?  
11 You're not relying on and you didn't offer any  
12 testimony with respect to any versions that were in  
13 commercial use between the late '90s and 1994, for  
14 example, right?

15 A I don't have personal knowledge, but there was  
16 testimony that the '989 patent fairly described the  
17 actual RIMS system as it was distributed.

18 Q There was also testimony from the inventors in  
19 their deposition that many of the functionalities in  
20 the '989 patent were never implemented. Do you recall  
21 reviewing that?

22 A Yes.

23 Q So what you're relying on when you offer your  
24 opinions, though, is just the '989 patent; isn't that  
25 right?



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1 A No.

2 Q Did you point to any other versions or produce any  
3 other documentation of the technical nature of the  
4 RIMS system as being used between 1989 and 2000?

5 A No, I didn't personally, because, as I said, I  
6 don't have personal knowledge of the RIMS system as  
7 distributed.

8 Q It would be fair to say that the inventors had  
9 personal knowledge of the RIMS system because they  
10 worked with it, right?

11 A I don't know what knowledge they had. I know what  
12 they said.

13 Q Well, you know that Mr. Momyer and Mr. Johnson are  
14 actually inventors of the '989 patent, correct?

15 A Yes.

16 Q So it would be fair to say that Mr. Momyer and  
17 Mr. Johnson are in a better position than you to  
18 understand what's in that patent, correct?

19 A I wouldn't say that. I think they might be in a  
20 better position to know what systems were actually  
21 distributed, but I can read the patent as well as they  
22 can.

23 Q So you know better than the inventors with respect  
24 to the '989 patent?

25 A Anybody can read the patent. The patent says what

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1 it says.

2 Q So with respect to the evidence you presented,  
3 though, did you present anything outside of the '989  
4 patent to support your opinions?

5 A Not in this courtroom.

6 Q Let's talk about the TV/2 search program for a  
7 minute, if we can. Do you recall talking about that  
8 system?

9 A Yes.

10 Q In preparing your report, nowhere in your report  
11 do you ever indicate that you saw a TV/2 search  
12 program in operation, correct?

13 A Correct.

14 Q Nowhere in your report did you say that you ever  
15 reviewed any TV/2 source code, correct?

16 A Correct.

17 Q Nowhere in your report did you indicate that you  
18 ever saw any user guides with respect to TV/2?

19 A Well, it depends on what a user guide is, but I  
20 revealed in my report exactly what TV/2 documents I  
21 looked at. Whether you want to characterize the  
22 general information manual as a user guide or not is  
23 up to you.

24 Q You never saw any demonstrations of the TV/2,  
25 correct?

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1 A Correct.

2 Q You never saw the Fisher prototype that was  
3 created as part of the electronic sourcing project  
4 that Fisher did with IBM?

5 A Correct.

6 Q You didn't see any technical documents with  
7 respect to the electronic sourcing project that IBM  
8 did with Fisher-Scientific, correct?

9 A Correct.

10 Q You never --

11 THE COURT: Wait a minute.

12 THE WITNESS: I don't think that's actually  
13 correct. I think there were some proposal documents  
14 or some technical descriptions, proposals, between IBM  
15 and Fisher that I looked at, I think.

16 Q It was a contract, a statement of work?

17 A Yes.

18 Q That was where they had to do almost a year and a  
19 half of work to come up with a working prototype for  
20 this system; isn't that right? That's what you're  
21 talking about?

22 A Yes.

23 Q You know a gentleman by the name of Mr. Charles  
24 Gounaris or are you aware of him?

25 A I'm aware of him. I don't know him.

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1 Q You reviewed his deposition in preparation for  
2 your testimony, correct?

3 A Yes.

4 Q And you're also aware of a young woman named  
5 Pamela Eng?

6 A I've heard the name. I don't know her.

7 Q You reviewed her deposition in preparation for  
8 your report, correct?

9 A Yes.

10 Q Are you aware that Mr. Gounaris and Ms. Eng are  
11 also paid witnesses for Lawson?

12 A I think I may have seen the name Gounaris on a  
13 schedule of witnesses that were going to testify. I  
14 don't recall Eng.

15 Q Well, did you make any effort to speak to  
16 Mr. Gounaris or Ms. Eng about their knowledge of the  
17 TV/2?

18 A No.

19 Q So it's fair to say you don't rely on some actual  
20 operating TV/2 system in your report because you never  
21 saw it, right? You just have two documents that  
22 you're relying on; isn't that right?

23 A Yes.

24 THE COURT: Which question do you want him to  
25 answer?

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1 MR. ROBERTSON: Excuse me, sir?

2 THE COURT: Which one of those questions do  
3 you want him to answer? There were about four in  
4 there.

5 MR. ROBERTSON: I'll rephrase, Your Honor.  
6 Thank you.

7 Q You rely on two documents to support your opinions  
8 in this case on the TV/2 system, correct?

9 A Yes, there's plenty in those two documents.

10 Q One is an advertising brochure, right?

11 A I think advertising brochure is your  
12 characterization. It's a brochure that describes the  
13 capabilities of the product.

14 Q Well, it's not a technical document; isn't that  
15 right?

16 A That's right.

17 Q And then there's a general information manual,  
18 correct?

19 A Yes.

20 Q And in your preparation for your report, did you  
21 review Ms. Eng's testimony where she indicated that  
22 that was not a technical document at well?

23 A I read that testimony.

24 MR. ROBERTSON: Could we see the '683 patent,  
25 the cover page, please. If you could blow up on the

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1 side, Mike, where it says "other publications."

2 BY MR. ROBERTSON:

3 Q You're aware, Dr. Shamos, that the inventors  
4 disclosed to the Patent Office the two documents that  
5 you rely on for your invalidity opinions; this IBM  
6 Technical Viewer general information manual and this  
7 IBM Technical Viewer/2 product information brochure,  
8 correct?

9 A Yes.

10 Q And you understand that the product brochure is,  
11 in fact, undated, correct?

12 A Yes.

13 Q You had no personal knowledge, do you, that either  
14 of these documents were ever in the public domain  
15 prior to August of 1993, do you?

16 A I have no direct personal knowledge of that.

17 Q So you understand that when these documents are  
18 disclosed to the Patent Office, the Patent Office can  
19 review them and consider them as part of the  
20 examination, correct?

21 A Yes.

22 Q Now, let me ask you about this RIMS patent and the  
23 disclosure in the patent at issue in this case. Is it  
24 your position that the '989 patent was not disclosed  
25 to the Patent Office?

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1 A It was not disclosed as prior art.

2 Q And you don't think when you disclose something in  
3 the background of the invention it can be considered  
4 by the Patent Office?

5 A Not for prior art purposes.

6 Q What's the basis of that opinion?

7 THE WITNESS: Your Honor, I can't answer that  
8 question without violating a ruling of the Court.

9 THE COURT: It's a legal opinion.

10 Q Let me ask you this: Have you seen places where  
11 the '989 patent was disclosed in the specification of  
12 the patent?

13 A Not as prior art.

14 Q Have you seen places in the patent, sir, can you  
15 answer my question, where the '989 patent was  
16 disclosed?

17 A It is disclosed not as prior art.

18 Q Was it disclosed as incorporated by reference?

19 A Yes.

20 MR. ROBERTSON: Why don't we pull up column 1  
21 of the '683 patent if we could.

22 Q If you'd go, please, to column 1, starting at line  
23 10, going down to line 17. The inventors here are  
24 telling the Patent Office that there are a number of  
25 known requisition purchasing systems that manage and

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1 process requisitions and purchase orders. One such  
2 system is the Fisher-Scientific requisition and  
3 inventory management system, Fisher RIMS, described  
4 United States Patent No. 5,712,989, filed April 2,  
5 1993, and assigned to Fisher-Scientific Company of  
6 Pittsburgh, Pennsylvania. The disclosure of which is  
7 incorporated herein by references. Do you see that?

8 A Yes.

9 Q Do you understand that when someone incorporates a  
10 patent by reference in the specification, it's as if  
11 it was fully set forth therein, isn't it?

12 A Yes.

13 Q And you don't have any misapprehension that when  
14 the inventors told the examiner and the Patent Office  
15 about this patent that they couldn't fully understand  
16 and comprehend that the inventors were saying  
17 everything that's in this patent is now considered to  
18 be part of the '683; isn't that right? That's what  
19 incorporated by reference means?

20 A Yes.

21 Q And you're aware, are you not, sir, that the RIMS  
22 patent and the RIMS system is mentioned in this patent  
23 more than 50 times, right?

24 A Yes.

25 Q So, again, the examiner couldn't have been under



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1 any misapprehension as to what was being disclosed as  
2 part of what RIMS functionality was necessary to be  
3 modified in order to come up with the inventions of  
4 the electronic sourcing patent, correct?

5 A Well, the examiner didn't consider it as prior  
6 art. The examiner considered it for what it said  
7 about the RIMS system.

8 Q Well, the examiner has access to be able to go and  
9 look at any patent, doesn't he, that's available in  
10 the Patent Office?

11 A Yes.

12 Q And if the inventors repeatedly throughout all 28  
13 columns of the patent described what they thought the  
14 RIMS system disclosed, he wasn't under any illusions  
15 as to what they were representing, was he?

16 A He was under an illusion.

17 Q Oh, I see. So you know what the examiner was  
18 thinking when he was reviewing the RIMS patent?

19 A Yes, I do because I read the file history. I read  
20 what he said.

21 Q You didn't offer any opinions in direct testimony  
22 with respect to the file history and what the examiner  
23 said, did you, sir?

24 A No, but you're asking me about it now.

25 Q So the answer to my question is no, you didn't

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1 offer any opinions with respect to the file history,  
2 correct?

3 A That's right.

4 MR. ROBERTSON: Could we go back and look at  
5 Claim Three again.

6 Q Now, you understand that for purposes of both  
7 infringement and invalidity you need to consider the  
8 claim as a whole; is that right?

9 A Yes.

10 Q And just using this claim as an example, this has  
11 six elements, I think, we've already confirmed, right?

12 A Yes.

13 Q And the preamble of the electronic sourcing system  
14 is also an element of the claim the Court has  
15 construed, right?

16 A Yes.

17 Q So when we go through this on an element by  
18 element basis, you're familiar with the term what's  
19 called an antecedent basis?

20 A Yes.

21 Q So let's look at the first element. The first  
22 element says that the electronic sourcing system has  
23 to have at least two product catalogs. I just want to  
24 zero in on that. Right?

25 A Yes.

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1 Q The next element says that this electronic  
2 sourcing system has to have a means for selecting the  
3 product catalogs, right?

4 A Yes.

5 Q So the product catalogs that are being referred to  
6 in this second element are the product catalogs that  
7 were identified in the first element, right?

8 A Yes.

9 Q Next element says you have to have a means for  
10 searching for matching items among the selected  
11 product catalogs. Do you see that?

12 A Yes.

13 Q The selected product catalogs that were being  
14 referred here are the product catalogs that were  
15 selected with the means in the second element, right?

16 A Yes.

17 Q The fourth element says you have to have a means  
18 for building a requisition using data relating to  
19 selected matching items and their associated sources.  
20 Do you see that?

21 A Yes.

22 Q The selected matching items here are the selected  
23 matching items that had been searched for in the  
24 selected product catalogs, right?

25 A Maybe.

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1 Q Excuse me?

2 A Maybe.

3 Q All right. And the means for processing the  
4 requisition to generate one or more purchase orders  
5 for the selected matching items refers to the selected  
6 matching items in the element above, right?

7 A Yes.

8 Q And then, finally, the means for converting data  
9 relating to selected matching item and then associated  
10 source to data relating to an item in a different  
11 source, those selected matching items are the ones  
12 that were placed on the purchase order in the element  
13 above, correct?

14 A Maybe.

15 Q And the sources that are being referred here refer  
16 back to the element three, which are the selected  
17 matching items and their associated sources, right?

18 A Maybe.

19 Q So we're talking about multiple sources there,  
20 right?

21 A Yes.

22 Q So if I don't have product catalogs in the prior  
23 art system, I can't satisfy any of these elements, can  
24 I?

25 A When you say the prior art system --

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1 Q Any prior art system. If I don't have a prior art  
2 system that has at least two product catalogs, then  
3 since all these elements in some part can or may  
4 depend on the one above, I can't satisfy any of those  
5 elements, isn't that right, since they all depend on  
6 the one above them? Can you answer that question  
7 fairly yes or no?

8 A Let me think about it. Yes.

9 Q All right. So if a prior art system doesn't have  
10 catalogs, it doesn't satisfy any of these elements,  
11 right?

12 A That's right.

13 Q So when you said the RIMS system, you considered  
14 for your purposes that it had all the elements of the  
15 claim except two or more catalogs; is that right?

16 A Yes.

17 Q But that's wrong now in consideration of the fact  
18 that if it doesn't have two product catalogs, it can't  
19 satisfy all the rest of these elements; isn't that  
20 right? Isn't that what you just said?

21 A It's right if you add the two product catalogs.

22 Q But if you don't have the two product catalogs  
23 which you assumed for purposes of your RIMS opinion,  
24 you don't satisfy any of the elements of the claim?

25 A That's right.

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1 Q And that would be true on any claim that has this  
2 antecedent basis where there is an element that  
3 includes a catalog and then there are other claims  
4 that would require the antecedent basis of a catalog;  
5 isn't that right?

6 MR. McDONALD: I object to the form, Your  
7 Honor. I think that's confusing.

8 MR. ROBERTSON: I'll rephrase. I think it  
9 was, too.

10 Q If there's a requirement of a catalog and then  
11 there's a subsequent element that relies on the fact  
12 that a catalog is in the claim, it couldn't satisfy  
13 that element, right?

14 A Right.

15 Q Isn't it true that the TV/2 reference does not  
16 disclose or suggest at least two catalogs a generally  
17 equivalent item from a different source said  
18 requisition module working in combination with said  
19 catalog searching module to determine multiple sources  
20 for said item?

21 A I wasn't expecting the question to be that long.  
22 Can you repeat that?

23 Q The TV/2 reference does not disclose or suggest at  
24 least two catalogs including a generally equivalent  
25 item from a different source said requisition module

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1 working in combination with said catalog searching  
2 module to determine multiple sources for an item,  
3 correct?

4 A Well, it certainly doesn't have all of that, no.

5 Q And the TV/2 reference doesn't disclose or suggest  
6 that the determination system including a cross  
7 reference table matching an identification code from a  
8 first located item with a second identification code  
9 from a second located item, right?

10 A Right.

11 Q And you would agree, wouldn't you, that there had  
12 to be an interface created between the TV/2 search  
13 programs and the RIMS system for an electronic  
14 sourcing system; is that right?

15 A Well, what I agree with is to integrate the two,  
16 one would have to create an interface, yes.

17 Q And you would agree also that additional search  
18 capabilities were added to the TV/2 search program for  
19 the Fisher electronic sourcing system; isn't that  
20 right?

21 A That's my understanding.

22 Q Is it your understanding that TV/2 search program  
23 could not do Boolean search functionalities when IBM  
24 presented it to Fisher-Scientific?

25 MR. McDONALD: Objection, Your Honor.

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1 Boolean search isn't one of the claims. It's  
2 irrelevant.

3 MR. ROBERTSON: I think search capability is  
4 and Boolean search capability is in the accused  
5 products and in the commercial embodiment. So I think  
6 it does have relevance.

7 MR. McDONALD: This is what I'm talking  
8 about, Your Honor. He's trying to match up things  
9 that have nothing to do with the claim by talking  
10 about Boolean searching. The issue is searching.

11 THE COURT: Why isn't that right?

12 MR. ROBERTSON: I think Boolean searching is  
13 a form of searching, Your Honor.

14 THE COURT: So what?

15 MR. ROBERTSON: I'll move on, Your Honor.

16 THE COURT: I sustain the objection.

17 BY MR. ROBERTSON:

18 Q Now, you're aware that when IBM met with  
19 Fisher-Scientific, they presented this TV/2 product as  
20 a potential product to use in the electronic sourcing  
21 project, correct?

22 A Yes.

23 Q And thereafter they entered into a contract and  
24 began working together, correct?

25 A Yes.



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1 Q And you're aware that Fisher committed significant  
2 resources to the project, correct?

3 A Yes, I think anybody would regard the expenditure  
4 as significant.

5 Q So they committed not only the expenditures, but  
6 they also committed human resources? That is, there  
7 were the four inventors, two of which were full-time  
8 on the project for a year and a half. You're aware of  
9 that, right?

10 A I don't recall who was full time and who wasn't,  
11 but they did commit human resources.

12 Q And they also had IBM commit significant  
13 resources; isn't that right?

14 A Yes.

15 Q And the project lasted a considerable time and you  
16 have seen that statement of work where there were over  
17 81 tasks that needed to be completed, correct?

18 MR. McDONALD: Objection, Your Honor. I  
19 don't see what relevance this has with anything. How  
20 long it took to put the product together has nothing  
21 to do with it.

22 THE COURT: Overruled.

23 Q Correct?

24 A I need you to repeat the question.

25 Q Sure. There was a statement of work I think that

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1 you referenced before that had a number of tasks that  
2 needed to be accomplished in order to complete the  
3 electronic sourcing project that led to a prototype  
4 for what is claimed in the inventions in this case,  
5 correct?

6 A Yes, I saw that.

7 Q And you also saw that Fisher-Scientific committed  
8 more than \$600,000 in cash to the project, correct?

9 A Yes.

10 Q And I don't know if I asked this already, but  
11 you're aware that it took some substantial time,  
12 perhaps as much as a year and a half?

13 A Yes.

14 Q Well, why isn't it when Fisher walked in IBM  
15 didn't say, You know, you don't need to do that.  
16 Here's a brochure. It's right here. There's the  
17 invention?

18 A Because IBM likes to charge money for services.

19 Q So you think they just did this whole thing as a  
20 charade for a year and a half working with  
21 Fisher-Scientific just to be able to charge money for  
22 their services?

23 A It wasn't a charade. What Fisher needed was a  
24 commercial product that would serve its needs. The  
25 commercial product is different from what's claimed in

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1 the patent. It has much more.

2 Q How do you know? You have never even seen the  
3 commercial product.

4 A But I've read the description of work.

5 Q But you didn't know what the actual commercial  
6 product was, right?

7 A As I said, I read the description of work, and  
8 what IBM and Fisher did together was a lot more than  
9 is claimed in the patents.

10 Q Let me ask you to take a look at what is  
11 Exhibit 4. Plaintiff's Exhibit 4. Do you have that?

12 A Yes. Well, it looks like a file history.

13 Q It's the file history for the '683 patent. Can  
14 you confirm that?

15 A Not at this resolution.

16 Q Well, it's in your notebook, I believe.

17 THE COURT: In that big notebook there in  
18 front of you, is that what you're talking about?

19 MR. ROBERTSON: Yes, sir.

20 THE COURT: Maybe it's easier to do that  
21 because I see his problem.

22 It's Plaintiff's Exhibit 4?

23 MR. ROBERTSON: Yes, sir.

24 THE COURT: Do you have it, sir?

25 THE WITNESS: Well, I have what's marked as

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1 PX 4, but it doesn't begin with the same cover page  
2 that's on the screen.

3 BY MR. ROBERTSON:

4 Q Why don't we just focus on what's in front of you  
5 if you can for now, and maybe I can direct you to a  
6 page that we're going to be focusing on. You did say  
7 you considered this for purposes of your report,  
8 right?

9 A Yes.

10 THE COURT: Which file history, the '683?

11 MR. ROBERTSON: Yes, sir.

12 Q If you'd go to -- do you see the lower right-hand  
13 corner there's a number of what are called Bates  
14 numbers. You're familiar with that term, right?

15 A Yes.

16 Q Actually, go to the page that starts with 721. Do  
17 you see that? Actually, if you start before that,  
18 there's a page 720. It says office action summary?

19 A Yes.

20 Q If you'd turn to the next page -- actually, yes,  
21 can you explain to the jury what an office action is,  
22 sir, if you know?

23 A I know.

24 Q What is it?

25 A During the prosecution of a patent, there's

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1 correspondence that takes place between the Patent  
2 Office and the applicant. The applicants will file an  
3 application and the office reviews it. And if they  
4 reject any claims or if they allow any claims, they do  
5 so by providing a document back to the applicant.

6 It's called an office action in which the nature of  
7 the action is stated and an explanation is given by  
8 the examiner for why he did what he did.

9 Q Here under heading No. 4 it says the disclosure is  
10 objected to because of the following informalities; do  
11 you see that?

12 A Yes.

13 Q The disclosure, that's what's contained in the  
14 application when the applicants first filed the patent  
15 describing what they believe their invention is,  
16 right?

17 A Yes.

18 Q That becomes the specification of the patent if  
19 the patent issues?

20 A Correct.

21 Q And it indicates here that the applicant must  
22 update some things. Do you see that?

23 A Yes.

24 Q One of the things it says, the application data on  
25 page 12 with the current status of each of the

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1 referenced applications, e.g. now abandoned or now  
2 patent number, question mark, or which is abandoned,  
3 and now a serial number, symbol, question mark, etc.,  
4 correct?

5 A Yes.

6 Q Why don't we go to page 575 of the document. Do  
7 you see here at the bottom of the page, in fact,  
8 there's a reference to an application number? Do you  
9 see it? It's a little difficult to read, but it's in  
10 the lower left-hand corner.

11 A Yes.

12 Q That application number has been crossed out and  
13 there the examiner has now written United States  
14 Patent No. 5,712,989. Do you see that?

15 A Yes.

16 Q So the examiner has appreciated that what was now  
17 being fully described was the actual '989 RIMS patent  
18 that it issued, correct?

19 A Well, what happened was that during the  
20 prosecution of the '683 patent, the '989 patent  
21 issued, and the examiner required the applicants to  
22 amend the specification to replace the word  
23 "application" with the patent number that was  
24 subsequently granted.

25 Q So there we have actually appreciation by the

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1 examiner that he understands that this is now the '989  
2 patent, right?

3 A No, he knew it was a patent.

4 Q That's why he put it in there, right?

5 A Yes.

6 Q Now, I think you agreed with me earlier that when  
7 you are going to apply for a patent or when you're  
8 looking at a patent for purposes of infringement or  
9 invalidity you need to look at it and read it as a  
10 whole, correct?

11 A I'm sorry. Could you say it again?

12 Q Yeah. You need to view the claim as a whole, not  
13 its little pieces, right?

14 A I didn't think it was phrased that way in your  
15 original question, but, yes, you evaluate the claim as  
16 a whole for invalidity purposes.

17 Q So you can't say, for example, if there's an  
18 element that says in determining whether there's a  
19 selected matching item available in inventory, you  
20 just can't go and focus on a prior art reference and  
21 say, Well, there is a discussion of inventory. So  
22 that element is satisfied. You have to read it in the  
23 context of the entire claim; isn't that right?

24 A Yes.

25 THE COURT: Is your question you have to read

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1 the prior art in context of the entire claim of the  
2 patent-in-suit? Is that your question?

3 MR. ROBERTSON: I think that's right, Your  
4 Honor.

5 THE COURT: You didn't make the antecedent  
6 noun clear.

7 MR. ROBERTSON: I'm sorry. Let me see if I  
8 can.

9 Q You have to consider whether the prior art  
10 satisfies that claim element when you look at the  
11 claim and consider it in its entirety; isn't that  
12 right?

13 A For obviousness purposes, you must consider the  
14 claim as a whole.

15 Q For anticipation purposes don't you need to  
16 consider the claim as a whole, as well?

17 A I don't think so.

18 MR. ROBERTSON: Can we look at slide 27, if  
19 we could.

20 Q This is what you relied on when you said RIMS  
21 search for items in multiple sources; do you see that?

22 A Yes.

23 Q And you had certain little excerpts from the '989  
24 patent. Do you see that?

25 A Yes.



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1 MR. ROBERTSON: Can we go to column 3 of the  
2 '989 patent and see the entirety?

3 BY MR. ROBERTSON:

4 Q While we're doing that, one of the things you said  
5 could be searched for was each product could regularly  
6 sold by the distributor, right?

7 A That's what the patent says.

8 Q I'm just saying this is what you cited to,  
9 correct?

10 A Yes.

11 Q And the distributor, you understand, that's being  
12 discussed in this section was Fisher, wasn't it?

13 A Well, it could be Fisher. If the product is used  
14 by others, it's not going to be Fisher.

15 Q In the context of this patent, the distributor is  
16 Fisher; isn't that right?

17 A I don't think that's correct.

18 Q We'll just say it's a distributor, all right?

19 A Yes.

20 Q And then down below where it's discussing this  
21 cross reference, a distributor catalog to its vendor's  
22 part number, a similar catalog number to other  
23 supplier or distributors. Do you see that?

24 A Yes.

25 Q That's what you're saying being searched here; is

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1 that right?

2 A Well, that's what the cross references are to.

3 Q That's not what the heading of your document is.

4 It's RIMS searched items from multiple source,

5 correct?

6 A Yes, if it's retrieving catalog number of other

7 suppliers and distributors, it's finding those items

8 from other sources and those sources being other

9 suppliers or distributors.

10 Q The last one says, Host database includes data

11 regarding items from third party suppliers; do you see

12 that?

13 A Yes.

14 MR. ROBERTSON: Now, can we see column 3 of

15 the '989 patent? It's PX 10. If you could blow up

16 the first half.

17 Q There's no search capability being described here

18 at all in this column 3, is there?

19 A Well, I just verified that the word "search" does

20 not appear on the screen, but that's the purpose of

21 databases is to be searched.

22 Q Sir, you were asked about figure 5(a) in this

23 patent. You represented that that was where we could

24 find that there were multiple purchase orders

25 generated from a requisition; is that right?

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1 A Yes.

2 Q But, specifically, sir, Mr. McDonald asked you  
3 that there was this product type 01, 03, 04, and if it  
4 was yes, you went in one direction, and if it was no,  
5 you went in another direction, correct?

6 A Yes.

7 Q And those were the two purchase orders you say  
8 that were created, correct?

9 A Well, it could be lots more than two.

10 Q All right. But those are the two different  
11 directions you went in to start to generate the  
12 multiple purchase orders you said were present in the  
13 RIMS system, correct?

14 A Yes.

15 Q But the one on the left side says, Customer  
16 internal purchase order; do you see that?

17 A Yes.

18 Q That's not part of the RIMS system, is it, sir?  
19 That's the customer's internal purchase order, right?

20 A I don't know what you mean "not part of the RIMS  
21 system." This is the '989 patent.

22 Q When you go into the customer internal P.O.,  
23 you're not in the RIMS system anymore, are you, sir?

24 A I don't know what that means. To the extent that  
25 the '989 patent is describing the RIMS system, it's

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1 part of the disclosure of the patent.

2 Q But the next thing says you create and print a  
3 purchase order internal to the customer; isn't that  
4 right?

5 A Yes.

6 Q That's the customer's purchase order, right?

7 A Yes.

8 Q Do you see these; 01, 03 and 04?

9 A Yes.

10 Q 01 is at table 1, these product types are in a  
11 table at column 5 and column 6 of the patent. 01 is  
12 the distributor-owned product, correct? That's  
13 distributor-owned item in a Just In Time warehouse  
14 located at or near the customer site, right?

15 A Right.

16 Q And 03 is a distributor catalog item like a Fisher  
17 catalog item stored in the distributor's warehouse,  
18 correct?

19 A Yes.

20 Q So that's a Fisher product, for example, a catalog  
21 product that they are storing in their own warehouse.  
22 And 04 is a third-party item that the distributor  
23 orders, correct?

24 A Yes.

25 Q So none of those are products that are from a

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1 vendor that is not a Fisher vendor, correct?

2 A Well, of course, they are.

3 Q Well, it's the distributors who has the product,  
4 isn't it?

5 A No, the distributor is just the intermediary. The  
6 distributor for product type 4, the distributor orders  
7 the part or item from whatever is manufacturing it or  
8 whoever is vending it.

9 Q But it's the distributor who actually is selling  
10 it, isn't it?

11 A Well, the distributor buys it from somebody else,  
12 and then the distributor sells it to the customer.

13 Q But that doesn't go through the RIMS system, isn't  
14 that right, for 04 type products?

15 A I don't know what you mean that it doesn't go  
16 through the RIMS system. It goes through the system  
17 that's described in the patent.

18 Q But then the customer service representative has  
19 to go out and actually outside of the RIMS system  
20 order that product, right?

21 A Well, that's one way of doing it.

22 Q Well, isn't that the way it's taught in the  
23 patent?

24 A It's in the preferred embodiment.

25 Q Human intervention is actually doing it, correct?

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1 It's not happening as part of an electronic process?

2 A There's a flow chart in figure 5. That flow chart  
3 can be implemented electronically. It can be  
4 implemented by computer.

5 Q But when you go to order that product, you  
6 understand, and what's disclosed in the patent you  
7 called preferred embodiment, the CSR then goes and  
8 actually contacts and obtains that product from the  
9 vendor; isn't that right?

10 A Well, that's one way of doing it, but when the  
11 distributor receives an order for a part that he does  
12 not have or does not stock, he goes and orders it. He  
13 can order it by having somebody pick up the phone or  
14 he can order it through electronic data exchange or  
15 whatever other interfaces he may have to its  
16 suppliers.

17 Q And that's not part of the electronic sourcing  
18 system that's claimed in the '683 patent, is it?  
19 That's all part of an electronic sourcing system, not  
20 somebody stopping all of a sudden saying I'm going to  
21 pick up the telephone and call a vendor and purchase  
22 an item; isn't that right?

23 A Well, I would agree that for the  
24 means-plus-function claims, the means isn't a human  
25 being.

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1 MR. ROBERTSON: Can you go to slide 32,  
2 please.

3 Q This is an excerpt from the '989 patent you relied  
4 on for RIMS checking inventory; isn't that right?

5 A Yes.

6 Q The inventory being checked there is  
7 customer-owned inventory, correct, at the JIT  
8 facility?

9 A That's one of the inventories being checked, yes.

10 Q And the second one is product type 01, which is  
11 the distributor-owned inventory, correct?

12 A Yes.

13 Q No inventory is being checked there for any other  
14 sources of the product; isn't that right?

15 MR. McDONALD: Objection, Your Honor,  
16 irrelevant. The claim doesn't talk about inventory.

17 MR. ROBERTSON: No, they talk about --

18 Q That's why you have to read the claims as a whole  
19 because they talk about inventory from selected  
20 matching items and their associated sources, don't  
21 they, sir?

22 A Yes.

23 MR. McDONALD: Objection.

24 THE COURT: Objection overruled.

25 Q So it has to be from an associated source, which

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1 is a vendor, a manufacturer or a supplier in the  
2 context of these claims; isn't that right?

3 A I don't think that's right.

4 Q Well, a catalog in which the item came from is  
5 provided by a vendor, a supplier or a manufacturer,  
6 right?

7 A I think that's right, yes.

8 Q So when we went down the claims before and all  
9 those antecedent bases, when we got down to checking  
10 for availability of a selected matching item, it was  
11 from the associated sources that had those multiple  
12 product catalogs, right?

13 A Yes.

14 Q So the sources from which the products are coming  
15 are from at least two vendors, correct?

16 A Yes.

17 Q So what you're checking here is the customer  
18 inventory and the Fisher inventory, correct? Those  
19 aren't two separate sources?

20 A But they are.

21 Q Not as defined by the Court when they have to be  
22 from a vendor, a supplier or manufacturer. The  
23 customer-owned product is not a vendor, a manufacturer  
24 or a supplier, correct?

25 MR. McDONALD: Object to his characterization



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1 of the claim terms. I don't even know which one he's  
2 talking about right now. I think it's getting very  
3 confusing.

4 MR. ROBERTSON: I'm using Claim Three, the  
5 one we've been going through this morning.

6 THE COURT: The objection was to the form of  
7 the question?

8 MR. McDONALD: Yes.

9 THE COURT: Sustained.

10 MR. ROBERTSON: I'll rephrase.

11 Q All you have identified here in this slide which  
12 you say discloses that RIMS checked inventory is the  
13 customer-owned inventory at a facility and the  
14 distributor-owned inventory, which is the Fisher  
15 product, correct?

16 A Yes, and those are two different sources.

17 Q The customer-owned inventory is what the customer  
18 already owns. It's not vending. It's not a vendor,  
19 supplier or manufacturer, is it?

20 A That's not true. That's what an internal purchase  
21 order is.

22 Q It's already customer-owned inventory sitting in a  
23 warehouse, isn't it?

24 A But it's not owned by the department that wants  
25 it. The department that wants it has to pay for it.

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1 Q Well, the company owns it, don't they? So you're  
2 saying that a vendor is an internal department of the  
3 company?

4 A It certainly can be. The department has to expend  
5 its funds in order to get that material.

6 Q So the internal department, say, of a company is  
7 in your view a manufacturer, a vendor or a supplier  
8 under the Court's definition?

9 A It certainly can be, yes.

10 THE COURT: So are you saying that if it's in  
11 the inventory of the customer, and -- well, let me ask  
12 you this: To be in the inventory of the customer, the  
13 customer has to pay for it, right?

14 THE WITNESS: Well, for it to get there in  
15 the first place, the customer --

16 THE COURT: Somebody has to pay for it.

17 THE WITNESS: The customer has to pay for it.

18 THE COURT: That's the company paying for it,  
19 right?

20 A Yes.

21 THE COURT: Does the department within the  
22 company according to your testimony have to pay again?

23 THE WITNESS: It has to pay another entity  
24 within the company. It can't go to the inventory and  
25 just take what it wants. It has to pay for it with

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1 internal funds.

2 MR. ROBERTSON: Can we go to slide 38, if we  
3 could.

4 BY MR. ROBERTSON:

5 Q Here you're saying RIMS was an order entry and  
6 inventory management system, correct?

7 A Yes.

8 Q And you rely on that for -- at column 1, lines 5  
9 through 7, correct?

10 A Well, that's an example.

11 Q Well, then you go on to say RIMS is a requisition  
12 system which will generally, and then quote "process  
13 purchase orders for items and track inventory." Do  
14 you see that?

15 A I didn't say that. That's from the patent.

16 Q Why don't we go to the patent if we can switch  
17 back. Column 1.

18 It's actually referring to -- if you go down below  
19 that -- two other systems, isn't it? To process  
20 purchase order items and track local inventory.

21 A I'm sorry. What's the question?

22 Q There it's being referred to two other systems in  
23 patent, 4888208 and 4972318, correct?

24 THE COURT: The question is whether the cited  
25 reference supports what he says because the cited

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1 reference when viewed in the whole refers to systems  
2 not to the patent. Is that what you're saying?

3 MR. ROBERTSON: Yes, sir.

4 THE COURT: Is that true or not?

5 THE WITNESS: I'm sorry. What's the -- could  
6 you just rephrase the question?

7 Q I'll just move on. Why don't we take a look at  
8 column 4, starting at about line 23. Here it's  
9 describing an embodiment, correct? That is Fisher and  
10 customer inventory, not multiple vendors, correct?

11 A Well, that's your characterization. The  
12 department wants to order something. The vendor can  
13 be another department within the company or it can be  
14 in the distributor-owned inventory. Those are two  
15 different sources, two different vendors.

16 Q The customer that's selling the product to itself,  
17 what's the basis for your opinion with respect to  
18 that?

19 A I have worked for a number of companies and that's  
20 the way it works. You don't get to take what you  
21 want. You have to pay for it.

22 Q So that makes the department within the company a  
23 vendor in your view?

24 A Yes.

25 Q Now, you're aware in the '683 disclosure in the

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1 application and in the specification, the inventors  
2 discussed a number of problems with the RIMS system as  
3 disclosed in the '989 patent, correct?

4 A They said that, yes.

5 Q And they informed the Patent Office repeatedly  
6 that this RIMS system as modified in the TV/2 system  
7 were merely preferred embodiments, correct?

8 A I think that's right.

9 Q And you would agree with me that the claims are  
10 not confined to the preferred embodiments, right?

11 A Yes.

12 Q And it's true that while the invention can be  
13 described in detail with reference to specific  
14 embodiments, it can be apparent to one skilled in the  
15 art that various changes and modifications can be made  
16 without departing from the spirit and the scope of the  
17 invention, correct?

18 A Yes, as a general proposition that's true.

19 Q And these three patents, the first one was filed  
20 in August of 1994?

21 A Yes.

22 Q And the last one issued, the '172 patent, issued  
23 in January of 2003, correct?

24 A I think so.

25 Q So all told, these patents were pending for over a

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1 period of nine years, correct?

2 A Yes.

3 Q And the Patent Office issued three separate  
4 patents, correct?

5 A Yes.

6 Q With 79 total claims?

7 A I don't recall the total number of claims.

8 Q And the examiner, do you know whether it was the  
9 same individual each time?

10 A I don't recall that.

11 Q Do you have any reason to dispute it? The patent  
12 says what the patent says, right? If it is, then it  
13 is?

14 A Exactly.

15 Q And in each instance, the examiner had before him  
16 the 2 TV/2 references that you relied on, correct?

17 A Yes.

18 Q And in each instance, he allowed the claims,  
19 right?

20 A Obviously.

21 Q If, in fact, Fisher-Scientific already had an  
22 electronic sourcing system in its RIMS patent, why  
23 would they expend all those resources, commit all that  
24 personnel, hire IBM, and spend all that money to come  
25 up with an invention which was something they already

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1 had?

2 A One, how could I know that?

3 Q Well, does it make sense?

4 A Sure it does.

5 Q To spend all that money and all those resources to  
6 get an invention you already have?

7 A Well, the invention is described --

8 THE COURT: Mr. Robertson, if he can't know  
9 why they did something, how can he answer the question  
10 whether it made sense because in order to answer the  
11 question why it made sense, you have to know why  
12 you're doing it, don't you?

13 MR. ROBERTSON: All right, Your Honor. I'll  
14 move on then.

15 BY MR. ROBERTSON:

16 Q You're not offering any opinions or have not  
17 offered any opinions with respect to whether or not  
18 any of the claims of these patents lack an adequate  
19 written description under the patent statute, correct?

20 A Well, I'd be happy to if you ask me.

21 Q But you haven't?

22 A No, not as of now.

23 Q When you were talking about the prior art, you  
24 were indicating that you needed to apply the Court's  
25 construction faithfully both for infringement and

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1 validity, correct?

2 A Yes.

3 Q You but when you gave your opinions with respect  
4 to infringement, you indicated that your understanding  
5 of published by a vendor, which is in the Court's  
6 construction of catalog, required in some way that the  
7 customer had to select the items to put in the  
8 database, correct?

9 MR. McDONALD: Objection, Your Honor. I'm  
10 not sure what he's characterizing at this point.

11 A I'd like that read back.

12 Q For purposes of infringement, you had opinions  
13 with respect to how the Court's term "published by a  
14 vendor" needed to be satisfied?

15 A I don't think I testified about that.

16 Q Well, didn't you testify that the data had to be  
17 modified in some way for inclusion in the item master,  
18 for example?

19 MR. McDONALD: I think he's confused at this  
20 point, Your Honor. Maybe this isn't a technical  
21 obvious, but I think he's talking about the opposition  
22 of what he testified about.

23 MR. ROBERTSON: Let me see if I can clarify  
24 this.

25 BY MR. ROBERTSON:



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1 Q You said that the item master didn't satisfy the  
2 catalog because the data was modified, could be  
3 modified or had to be modified in some way, right?

4 A I gave many reasons.

5 Q Is that one?

6 A That was one.

7 Q And the customer could delete information, so  
8 that's why it didn't satisfy the Court's definition?

9 A I don't think I said it that way.

10 Q I think you said that -- well, let me ask you  
11 this. Didn't you indicate that it doesn't satisfy the  
12 Court's construction if only a partial items were  
13 entered into the item master?

14 MR. McDONALD: Your Honor, I think we're back  
15 on the infringement part of the case, and I think it's  
16 getting awfully confusing. I object. It's outside  
17 the scope of my direct examination.

18 THE COURT: I thought that's what we were  
19 doing. Why are you doing this? Are you trying to  
20 establish that he said one thing in infringement and  
21 another in invalidity and that's why you're asking  
22 about infringement?

23 MR. ROBERTSON: Yes, sir.

24 THE COURT: Well, then the objection is  
25 overruled. You can do that, if you can do it.

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1 BY MR. ROBERTSON:

2 Q Didn't you indicate for purposes of infringement  
3 that if the item master didn't contain the entire  
4 catalog, it didn't satisfy the Court's construction as  
5 published by a vendor?

6 A No.

7 Q Did you say even if a customer loads all item data  
8 from a published vendor, if it only comes from one  
9 place, that it doesn't mean it's a catalog within the  
10 Court's construction?

11 A I don't think I said that.

12 Q Let me start back -- I don't think I asked you  
13 this question. You had some slides and you were asked  
14 about some bullet points. One of the bullet points  
15 was about the catalog at issue. Let me ask you this:  
16 Isn't it true you said that you had to look at where  
17 the data in the item master comes from because the  
18 item master starts out empty when the system is  
19 installed. Do you recall that?

20 A Yes.

21 Q The TV/2 starts out empty, doesn't it?

22 A Well, the TV/2 system as delivered by IBM starts  
23 out empty.

24 Q Didn't you give an opinion with respect to  
25 infringement that in order to satisfy the Court's

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1 construction published by a vendor - excuse me - of  
2 published by a vendor, that's right, it has to be  
3 carefully handpicked by a customer who decides what to  
4 import?

5 A No. That's confusing and wrong. I don't know  
6 what that means.

7 Q You said it wouldn't satisfy the claim if it were  
8 carefully handpicked by a customer and the customer  
9 decided what to import into the item master, correct?

10 A Yeah. We had a discussion about how much of a  
11 catalog would you have to import for it to remain a  
12 catalog, and at what point wouldn't it be a catalog  
13 anymore.

14 Q But your opinion was that if a customer decides  
15 what to import into an item master, that doesn't  
16 constitute a catalog, correct?

17 A It may not.

18 Q You didn't offer any opinions with respect to  
19 invalidity as to whether a decision was made to import  
20 some data into this TV/2 and RIMS combination you had,  
21 whether that would constitute a catalog, didn't you?

22 A But many times during my testimony I said under  
23 the plaintiff's theory of infringement --

24 Q I'm not talking about the plaintiff's theory of  
25 infringement. I'm talking about what you say was

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1 required under the Court's construction for published  
2 by a vendor, not our theory. We don't have a theory.  
3 We're following the claim construction. I want to  
4 know what you said satisfied the claims. You said if  
5 the customer only imported some of the data, it didn't  
6 constitute a catalog, correct?

7 A Yes.

8 Q You didn't offer any opinions with respect to that  
9 on this TV/2 and RIMS invalidity argument, did you?

10 A But in TV/2 --

11 THE COURT: Yes or no? Did you offer those  
12 opinions?

13 THE WITNESS: Yes.

14 MR. ROBERTSON: I guess the record will speak  
15 for itself on that.

16 BY MR. ROBERTSON:

17 Q Did you indicate in your opinions on validity that  
18 the TV/2 brochure disclosed searching for catalogs,  
19 correct?

20 A Searching in catalogs, yes.

21 Q Didn't you indicate that the search was how the  
22 TV/2 can select the catalog to search?

23 A I'm sorry?

24 Q Didn't you indicate that the TV/2 brochure taught  
25 that you can select a catalog to search by searching

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1 for a catalog?

2 A No. There's a disclosure in the TV/2 literature  
3 that you can store multiple catalogs on hard disk and  
4 there's a discussion of the search interface whereby  
5 you can specify which portion of the database you'd  
6 like to search.

7 Q Selecting a catalog, can that be a search?

8 A Well, you may have to search for --

9 Q Can selecting a catalog be a search, sir?

10 A I can't answer yes or no.

11 Q Isn't it true that the RIMS parts master didn't  
12 have the entire Fisher catalog imported into it?

13 A I'm sorry. I was coughing. Could you repeat?

14 Q Yes. Isn't it true that the RIMS parts master  
15 didn't have an entire Fisher catalog imported into it?

16 A I don't know that.

17 MR. ROBERTSON: If I could just have a  
18 minute, Your Honor.

19 All right. Thank you. That's all I have.  
20

21 REDIRECT EXAMINATION

22 BY MR. McDONALD:

23 Q Good morning Dr. Shamos.

24 A Good morning.

25 Q I'd like to turn first to the issue of the

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1 sourcing of products relating to customer's inventory.

2 MR. McDONALD: Can we go to the '989 patent  
3 the RIMS patent, please, DX 7. Can we go to column  
4 11. Could you blow up the section of the left column  
5 that starts with the heading "sourcing," and then blow  
6 it up from there on down.

7 BY MR. McDONALD:

8 Q We've got up on the screen now, Dr. Shamos, from  
9 the '989 RIMS patent column 11 beginning at line 25  
10 and going to line 47. Do you see that?

11 A Yes.

12 Q Now, does this section of the RIMS patent relate  
13 at all as to whether or not -- relate at all to the  
14 sourcing issue?

15 A Yes.

16 Q Can you explain to us what is being described here  
17 if we walk through this? For example, in the first  
18 paragraph there, it talks about what sourcing is,  
19 right?

20 A Yes.

21 Q What does it indicate that sourcing is?

22 A Sourcing -- I'm reading from the second line of  
23 text. Sourcing the requisition is the process of  
24 determining what inventory will be used to fill the  
25 requisition.

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1 Q So it could be purchased or it could come from an  
2 inventory. That's all sourcing, right?

3 A Yes.

4 Q So if we go down to the third paragraph here --

5 MR. ROBERTSON: Just so it's clear, it also  
6 says for all product types except 05 and 06. I think  
7 for clarity, you ought to identify what 05 and 06  
8 products are.

9 Q Let's verify the next sentence, Dr. Shamos. Can  
10 you read the next sentence after the highlighted one?

11 A Yes. Pricing is also performed in this step when  
12 it's called for, e.g., for all product types except  
13 for 05 and 06.

14 Q Well, pricing is something different from  
15 sourcing, isn't it?

16 A Yes.

17 Q It's got nothing to do with this, right?

18 A That's right.

19 Q If we could go to the third paragraph, please,  
20 where it says sourcing is performed on both local  
21 computer 40 and host computer 10. Do you see that  
22 paragraph?

23 A Yes.

24 Q Well, let's take a look at this next sentence in  
25 some detail.

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1 MR. McDONALD: Can we blow up the next  
2 sentence, please.

3 Q Sourcing in the preferred embodiment of the  
4 system, we're talking but the RIMS system here, right?

5 A Yes.

6 Q Of the present invention can involve up to four  
7 different product types: 01, local distributor-owned  
8 JIT the items; 03, distributor catalog items; 04,  
9 third party items which are ordered by the  
10 distributor; type 06, customer-owned JIT items; do you  
11 see that?

12 A Yes.

13 Q So these are the different product types that are  
14 all sourced in the RIMS system, correct?

15 A Yes.

16 Q Now, the internal customer purchase order that you  
17 were referring to, is that sometimes called an  
18 administrative purchase?

19 A Yes.

20 MR. McDONALD: Can we turn to the '683  
21 patent, please, the patent-in-suit. Can we go to  
22 column 18. Can you blow up the section beginning at  
23 line 17 or 18 of column 18, and then the list of 3  
24 bullet points.

25 BY MR. McDONALD:



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1 Q So this is from the '683 patent, but this is in  
2 all the patents-in-suit; is that right, Dr. Shamos?

3 A Yes.

4 Q Can you tell us what being described here in the  
5 '683 patent at column 18?

6 A Well, what's being described is the generation of  
7 one or more purchase orders.

8 Q That first item there, what is that? It says, "An  
9 order from the customer to the supplier, an  
10 administrative purchase."

11 A Well, that seems to contradict what we were  
12 talking about before about what an administrative  
13 purchase is because that doesn't look internal.

14 THE COURT: Well, it can't be internal  
15 according to the construction.

16 Q Well, if we look at --

17 THE COURT: Can it?

18 MR. McDONALD: Yes, it can. Well, let me  
19 walk through this.

20 THE COURT: Are you trying to make a point  
21 here that when a company owns something in inventory,  
22 and it's paid for it, and one department has it but  
23 another department wants it, and there's a bookkeeping  
24 entry to reallocate funds within the company, that you  
25 have a vending going on; is that the point?

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1 MR. McDONALD: That's sourcing, Your Honor.

2 THE COURT: Well, I'll let the jury decide  
3 whether it is or not, I guess, but --

4 BY MR. McDONALD:

5 Q You just testified that the whole RIMS  
6 specification is incorporated by reference into the  
7 patents in this suit, correct?

8 A Yes.

9 Q And in the RIMS patent, doesn't it specifically  
10 say that those customer internal transactions are  
11 called purchase orders?

12 MR. ROBERTSON: Objection, leading.

13 THE COURT: Let him testify. That's enough.

14 Q All right. So does --

15 THE COURT: Sustained.

16 Q Does the RIMS specification describe the internal  
17 customer transaction?

18 A Yes, we went through this in discussing figure 5,  
19 which has the decision block when processing a  
20 requisition looking at the different type codes and  
21 deciding whether to issue an internal purchase order  
22 or not an internal purchase order.

23 Q That was from that figure 5A of the RIMS patent,  
24 correct?

25 A Yes.

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1           MR. McDONALD: Can we put figure 5A back up,  
2 please, from the '989 patent.

3 BY MR. McDONALD:

4 Q So for purposes of the RIMS disclosure that's  
5 incorporated into the patents-in-suit, is there  
6 anything from figure 5A that indicates what that  
7 internal customer transaction is actually called?

8 A Well, it says -- it refers to in block 334,  
9 customer internal P.O.

10 Q What does P.O. stand for?

11 A Purchase order.

12           MR. McDONALD: Well, can we go to column 17  
13 of the '989 patent. Could you blow up a section from  
14 lines 35 to 43, please.

15 BY MR. McDONALD:

16 Q I think you were asked some questions about  
17 whether the system generates the purchase orders in  
18 those figures 5A and 5B or not. I'd like to direct  
19 your attention to this paragraph, Dr. Shamos. Can you  
20 tell us what this paragraph of the RIMS patent is  
21 explaining about that purchase order building process?

22 A Yes, it's describing what happens, for example,  
23 for items of product types 1, 3 and 4. It creates a  
24 purchase order between the customer and the  
25 distributor.

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1 Q Does it refer to figures 5A and 5B to support that  
2 statement or not?

3 A Yes.

4 Q What does it indicate in terms of what system uses  
5 the purchase order build program? Was it that local  
6 computer?

7 THE COURT: Let him testify.

8 A Well, it says for items of product types 01, 03  
9 and 04, local computer 40 uses purchase order build  
10 program 112 to create a purchase order.

11 Q If we go to figure 2A of the '989 patent --

12 MR. ROBERTSON: Objection, outside the scope.  
13 I didn't ask anything about figure 2A.

14 MR. McDONALD: It's referred to in this  
15 paragraph that refers to 5A.

16 THE COURT: Well, that doesn't make it  
17 something that was a topic of his examination.  
18 Sustained.

19 BY MR. McDONALD:

20 Q Let's turn now to the patent, the file history,  
21 Exhibit 4, that Mr. Robertson was asking you about.  
22 He was asking you about whether or not -- well, let's  
23 talk about the issue of whether or not there was a  
24 disclosure to the Patent Office that any aspect of the  
25 RIMS system was actually prior art. Did you look at

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1 the file history, Exhibit 4, to determine whether or  
2 not the RIMS system was actually disclosed as prior  
3 art?

4 A Yes.

5 Q What did you conclude about that?

6 A It wasn't.

7 Q What's the basis for that conclusion?

8 MR. ROBERTSON: Objection. This calls for  
9 legal conclusions.

10 MR. McDONALD: He's asked the exact same  
11 questions. I want to get a chance for him to explain  
12 his reasoning.

13 MR. ROBERTSON: I didn't ask --

14 THE COURT: He didn't ask him the reasoning.  
15 He volunteered that. Mr. Robertson opposed it.

16 MR. McDONALD: Well, the exact issue was is  
17 the RIMS system disclosed as prior art.

18 THE COURT: I ruled. It's over. I'm not  
19 going to have you testifying about the law.

20 BY MR. McDONALD:

21 Q Dr. Shamos, is there any documentation in the file  
22 history of Plaintiff's Exhibit 4, the '683 file  
23 history, that goes specifically to the issue of  
24 disclosing prior art to the Patent Office?

25 MR. ROBERTSON: Objection, Your Honor. It's

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1 the same question asked in a way --

2 MR. McDONALD: This is a fact. I'm not  
3 asking him for an opinion. This is a fact.

4 THE COURT: It's the same. It's another way  
5 of doing the same thing, I think. There may be a  
6 question you can ask. I'm not going to get into  
7 asking it, but that isn't the one.

8 BY MR. McDONALD:

9 Q Dr. Shamos, is there -- I think you were asked  
10 about whether the TV/2 documentation was considered by  
11 the Patent Office, correct?

12 A Yes.

13 Q Now, is there something in the file history of the  
14 '683 patent that would indicate how it was that the  
15 TV/2 publications were disclosed to the Patent Office?

16 MR. ROBERTSON: I'm going to object, Your  
17 Honor, because now we're just going over the direct  
18 examination again. This was already asked in direct  
19 and I didn't raise this issue again in my  
20 cross-examination. I just asked him where the '989  
21 was referenced in the file history and the  
22 specification.

23 MR. McDONALD: You did ask him about the  
24 TV/2.

25 THE COURT: Yeah, but not that. You're

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1 really retreading. You're repeating basically what  
2 you said on direct examination, and that isn't what  
3 redirect is about. So let's go on to something that  
4 he actually asked about.

5 MR. McDONALD: Okay.

6 BY MR. McDONALD:

7 Q Can we go to the office action in the file  
8 history? Turn to page, I think it would be about 182.

9 MR. McDONALD: Could you blow that up, Bill.  
10 The number ending with 3720.

11 THE COURT: Do you want to blow the number up  
12 or the picture up?

13 MR. McDONALD: I just want to help Dr.  
14 Shamos --

15 THE WITNESS: I have it.

16 BY MR. McDONALD:

17 Q So this is the same office action you were asked  
18 about earlier, correct?

19 A Yes.

20 MR. McDONALD: Can we go to the two pages  
21 later, please. Its part of this office action.

22 THE COURT: Can you blow that up? Can you  
23 read that, Dr. Shamos?

24 THE WITNESS: Well, I'm reading from the  
25 original document.

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1 THE COURT: All right. Well, the jury is  
2 being asked to look at it here, and I can't read it,  
3 and I don't see how they can read it. So if you can  
4 blow it up, let's get to where you want to go. Where  
5 are you going?

6 MR. McDONALD: Paragraph No. 7 here from the  
7 office action.

8 MR. ROBERTSON: I'm going to object, Your  
9 Honor. I didn't ask anything about this page or  
10 paragraph 7.

11 MR. McDONALD: Well, he was asking about this  
12 in the context of the disclosure of the RIMS prior  
13 art. I'd like to go to that exact same issue. They  
14 are part of the same document and talk about that  
15 issue of disclosure of RIMS as prior art.

16 MR. ROBERTSON: The only reason I sited this  
17 office action was to show --

18 THE COURT: Come up here, please.

19 (The following sidebar conference is begun.)

20 THE COURT: Is it your view of the law that  
21 if something is disclosed in the text of the patent  
22 that it can't be considered as prior art unless it is  
23 listed somewhere else in the patent as prior art? Is  
24 that what you say the law is?

25 MR. McDONALD: I think the law is just



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1 because it's incorporated by reference does not  
2 mean --

3 THE COURT: What case do you have that says  
4 that?

5 MR. McDONALD: Well, I don't have a case. I  
6 have all the Patent Office actions on the reexams.

7 THE COURT: I don't care about that. I care  
8 about the law. What you're suggestion is something  
9 that I don't understand to be the law.

10 And do you have a case on it?

11 MR. ROBERTSON: I have what's called the  
12 MPEP, which is the Manual for Prosecution and  
13 Examination Procedures, and I believe there's a  
14 procedure in there that if it's disclosed in the  
15 background of the invention, it's presumed that the  
16 examiner has considered it. He can read, Your Honor.  
17 It's there 59 times.

18 THE COURT: And there is no section in the  
19 patent that says prior art?

20 MR. McDONALD: Well, the references cited is  
21 the section that refers to the prior art.

22 THE COURT: No. That's how you refer to it,  
23 but it doesn't call it prior art. It doesn't say --  
24 is there any rule that says you have to put all of  
25 your prior art in the references section?

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1 MR. McDONALD: That is, again, the MPEP  
2 process is that you disclose prior art --

3 THE COURT: I didn't ask you that. I said,  
4 Is there rule that says that? Not what they do, but  
5 what is the rule?

6 MR. McDONALD: I believe there is a rule that  
7 the Patent Office puts all the prior art in the list  
8 of references cited. I don't have the rule cite at my  
9 fingertips.

10 THE COURT: Well, you're making a lot of  
11 paper over nothing unless there's a rule that does it.  
12 Somebody has got to know the answer to that.

13 MR. ROBERTSON: I'll look into it, Your  
14 Honor. We'll tell you on the video that you played  
15 said the examiner can look at the prior art references  
16 and the references discussed in the background of the  
17 invention.

18 THE COURT: It's in the video. I know.  
19 That's why I'm asking the question, for Pete's sake.  
20 It's confusing to the jury to be doing what you're  
21 doing. That's why I'm concerned about this. So the  
22 way you're asking these questions suggests that it's  
23 required when in fact they have already been told that  
24 it isn't.

25 And if that reference is wrong, then I need

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1 to know it and straighten it out, but I don't think it  
2 is wrong.

3 MR. ROBERTSON: We did give you the case law  
4 for a supplemental instruction on what incorporated by  
5 reference means.

6 THE COURT: That's different.

7 MR. ROBERTSON: When it's incorporated by  
8 reference, it's all -- the entire patent is fully  
9 disclosed therein. It's as if it's part and parcel of  
10 the whole patent.

11 THE COURT: That's correct unless there is a  
12 rule that says to be considered prior art, it has to  
13 be in the -- is it cited references?

14 MR. ROBERTSON: Yes, sir.

15 MR. McDONALD: References cited.

16 THE COURT: References cited. And I don't  
17 think it is.

18 MR. ROBERTSON: I don't think so either.

19 THE COURT: I don't think it is, which is why  
20 I don't think it's the rule.

21 MR. McDONALD: I did want to show in this  
22 section --

23 THE COURT: You can do it, but change your  
24 question so you don't do this. Don't cause that  
25 problem. You can ask a question without -- and I

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1 don't want him saying another thing about has it been  
2 disclosed as prior art.

3 MR. ROBERTSON: We're going into a different  
4 section. It has nothing to do with --

5 THE COURT: What does it have to do with?

6 MR. McDONALD: Well, the RIMS patent  
7 application clearly disclosed --

8 THE WITNESS: Put that back up. Okay. I've  
9 got what I want. I can't make any sense out of this  
10 because I don't have the whole text.

11 MR. McDONALD: I'll just move on.

12 THE COURT: Okay.

13 BY MR. McDONALD:

14 Q Dr. Shamos, you were shown a part of the file  
15 history that showed that the original application, the  
16 RIMS application, was described as an application  
17 about a patent number, correct?

18 A Yes.

19 Q When the patents in this suit were filed, was that  
20 disclosure of the RIMS patent application that was not  
21 in the issued patent, was that something that you  
22 considered to be prior art at that point in time?

23 MR. ROBERTSON: I'm going to object, Your  
24 Honor.

25 THE COURT: The question is whether he

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1 considered it. And the answer is yes or no.

2 In forming your opinion, did you consider  
3 the prior art or not?

4 BY MR. McDONALD:

5 Q At that point in time on the filing date of the  
6 patents.

7 A I'm not sure that I understand the question.

8 THE COURT: Okay. Then let him rephrase it.

9 BY MR. McDONALD:

10 Q When is it that the RIMS patent became prior art?

11 MR. ROBERTSON: That's actually calling for a  
12 legal conclusion.

13 THE COURT: Yes, it is.

14 Q Did you have an understanding, Dr. Shamos, from  
15 your standpoint as to when that RIMS patent would have  
16 become prior art?

17 THE COURT: Start all over again. Did you  
18 consider when you were making your analysis that, as  
19 of the date of the patent at issue, did you consider  
20 the RIMS patent as prior art? Is that what you asked  
21 him?

22 MR. McDONALD: I think the question is when  
23 did it become prior art?

24 THE COURT: What?

25 MR. McDONALD: My question is what is his

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1 understanding as to when the RIMS patent became prior  
2 art.

3 THE COURT: No. The question is whether he  
4 considered it as prior art. That's where you started  
5 out. Did you consider as prior art the RIMS patent,  
6 '989, right?

7 BY MR. McDONALD:

8 Q Okay, we can start there.

9 A For purposes of forming my opinions on validity, I  
10 considered the '989 patent to be prior art.

11 Q And that patent issued in January of '98, right?

12 A Yes.

13 Q How long after the patents were filed did that  
14 issue approximately?

15 MR. ROBERTSON: Your Honor, I didn't go into  
16 any inquiry about this.

17 THE COURT: Actually, you did.

18 MR. ROBERTSON: As to the date --

19 THE COURT: It's obvious between the date of  
20 the application and the date of the issuance. It's  
21 right on the face of the patent. And I think you did  
22 ask him about it.

23 Are you asking him what's the difference  
24 between the dates?

25 It was filed when? Do you remember. It's on

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1 the face of the patent.

2 THE WITNESS: It was filed in 1993. I'm  
3 sorry. 1994.

4 BY MR. McDONALD:

5 Q So let's talk a little bit about the J-CON and  
6 P.O. Writer prior art that Mr. Robertson asked you  
7 about.

8 MR. ROBERTSON: I object, Your Honor,  
9 referencing this prior art.

10 THE COURT: He didn't testify about it. In  
11 fact, he said he didn't. So you can't ask him about  
12 that.

13 MR. McDONALD: He was asked about it in his  
14 cross-examination.

15 THE COURT: But the fact that he was -- I  
16 don't think that I would have asked that question, but  
17 that didn't open the door to a whole new set of  
18 testimony on that topic. All he did is say he asked  
19 him whether he gave the opinion or not. And he said,  
20 No, I didn't. And that's the end of it because you  
21 don't need to go into it unless you think that he did  
22 give an opinion, and that that answer was wrong by  
23 Dr. Shamos, and you need to correct it. And he didn't  
24 give the opinion. So you don't need to correct  
25 anything. So let's move on.

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1 BY MR. McDONALD:

2 Q What was the relevance of your testimony about the  
3 J-CON and P.O. Writer products, Dr. Shamos, that you  
4 gave in this court?

5 THE COURT: Let's see. What's the relevance?

6 MR. McDONALD: That sounds a little funny.

7 THE COURT: Generally, don't you ask judges  
8 to rule on that?

9 MR. McDONALD: I think you're right.

10 BY MR. McDONALD:

11 Q Dr. Shamos, can you explain to us what the  
12 importance was of the J-CON and P.O. Writer systems to  
13 your invalidity opinions that you provided in court  
14 yesterday?

15 MR. ROBERTSON: That's outside the scope. I  
16 just asked him if he had opinions on invalidity with  
17 respect to those two references, and he said no. And  
18 now --

19 THE COURT: Does that show you why you  
20 shouldn't have asked that question and just argued it?

21 MR. ROBERTSON: He is redirecting it. He's  
22 going over what he went over on direct. So now we're  
23 just going back to direct on redirect.

24 THE COURT: Sustained. Let's go.

25 BY MR. McDONALD:



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1 Q You were asked about materials you reviewed with  
2 respect to the RIMS system. Do you recall that?

3 A Yes.

4 Q In your expert report in this case, you indicated  
5 that you looked at something called the RIMS trademark  
6 file history as part of the documents, correct?

7 MR. ROBERTSON: I didn't ask him anything  
8 about that, Your Honor. I asked about the '989  
9 patent.

10 MR. McDONALD: He asked about the  
11 documentation regarding the RIMS system that he  
12 reviewed.

13 MR. ROBERTSON: I asked him if he had  
14 awareness of any of the commercial embodiments and I  
15 asked him -- and he said no, he relied on the '989  
16 patent --

17 THE COURT: It's beyond the scope.  
18 Sustained.

19 BY MR. McDONALD:

20 Q Do you recall Mr. Robertson's question, Dr.  
21 Shamos, where they put up one of the claims on the  
22 screen and talked about how catalogs interacted with  
23 the various elements of the claims?

24 A Yes.

25 Q That issue of whether or not the system, the

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1 combination of the RIMS and TV/2 systems, taught or  
2 suggested the use of multiple catalogs, is that pretty  
3 important to your analysis or not?

4 MR. ROBERTSON: I object to the form of that  
5 question, Your Honor. Vague and ambiguous. Pretty  
6 important to your analysis?

7 THE COURT: I think so. Sustained.

8 BY MR. McDONALD:

9 Q Does the issue of whether or not that combination  
10 of the RIMS and TV/2 system teaches or suggests  
11 multiple catalogs, is that something that's important  
12 to a number of the elements of the claims in this case  
13 or not?

14 A It is.

15 MR. McDONALD: I have no further questions.  
16 Thank you.

17 THE COURT: May he be excused permanently?

18 MR. McDONALD: I believe so.

19 THE COURT: Thank you for being with us, Dr.  
20 Shamos. You're excused.

21 THE WITNESS: You're welcome.

22 (The witness was excused from the witness  
23 stand.)

24 THE COURT: Next witness.

25 MR. ROBERTSON: Your Honor, I believe we need

1 to make a motion.

2 MR. McDONALD: I get to rest first.

3 THE COURT: You can't make anything yet.

4 MR. McDONALD: The defense rests, Your Honor.

5 THE COURT: Thank you.

6 Ladies and gentlemen, we'll take the morning  
7 recess now. It may be a little bit longer than 20  
8 minutes because I have a matter to take up with the  
9 lawyers. We'll let you know.

10 (The jury is exiting the courtroom.)

11 THE COURT: All right. You're motion is  
12 going to take how long, Mr. McDonald?

13 MR. McDONALD: Our motion?

14 THE COURT: Yes, your motion.

15 MR. ROBERTSON: I understood we were making  
16 JMOL -- no invalidity, but I understood Your Honor to  
17 indicate that we were going to take that up on Friday.

18 THE COURT: I'm trying to figure out just  
19 timing, that's all. How long do you see this motion  
20 process taking, given that we're going to hear the  
21 arguments on Friday? Just a short one?

22 MR. McDONALD: We have infringement and  
23 validity as well.

24 MR. ROBERTSON: Can we confer at the break,  
25 Your Honor. I think we could probably -- I estimate

1 less than an hour total.

2 THE COURT: I'm talking about now. In order  
3 to put it on the record, do you just have five  
4 minutes.

5 MR. ROBERTSON: Two minutes.

6 THE COURT: We'll do all that after the break  
7 then.

8 We'll get 20 minutes and we'll come back and  
9 deal with it.

10 (Luncheon recess taken.)

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